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674519-2001.4IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Michael John Reed et al.  
 Serial No. : 10/084,235  
 For : STEROID SULPHATASE INHIBITORS  
 Filed : February 25, 2002  
 Examiner : Badio, Barbara P.  
 Art Unit : 1616

745 Fifth Avenue, New York, NY 10151

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*Angela M. Collison*

Signature

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 March 29, 2006

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 Date of Signature
INFORMATION DISCLOSURE STATEMENT

Mail Stop Issue Fee  
 Commissioner for Patents  
 P.O. Box 1450  
 Alexandria, VA 22313-1450

The Examiner's attention is respectfully directed to the document listed on the enclosed PTO-1449, a copy of which is enclosed herewith.

This information disclosure is not a representation that the cited document is considered pertinent, or that the cited document is indeed prior art. And, it is believed that the document cited herein presents no new issues requiring any further search or examination.

It is respectfully requested that the Examiner consider and make of record the document herein cited and that a copy of Form PTO-1449 be initialed by the Examiner and returned to the undersigned. To the extent that a Petition is required for entry, this paper is to serve as such.

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As this Information Disclosure Statement is being filed after the payment of the issue fee, the Commissioner is authorized to charge any required fees or credit any overpayment in fees to Deposit Acct. No. 50-0320.

And, in this regard, it is noted that the Rules and the MPEP do not prohibit the Examiner from considering and making of record documents cited at this stage of the prosecution.

37 C.F.R. § 1.97(i) provides that after the Notice of Allowance, the applicant does not have a right to have references cited in an IDS considered.

However, if an IDS filed after the Notice of Allowance is received by an Examiner, and (s)he decides (1) to consider each document, (2) initial the IDS to indicate that (s)he has done so and (3) the documents cited are to appear on the front of the patent, there is nothing in 37 C.F.R. § 1.97(i) to prevent her/him from doing so, as is respectfully requested in this application. See also 37 C.F.R. §§ 1.181-1.183; namely that acceptance of this Information Disclosure Statement by the Examiner can be within 37 C.F.R. §§ 1.181-1.183, especially because non-acceptance of it can result in the Applicants requesting continued prosecution which can cause a loss of patent term.

The actions of the Examiner in considering the document cited herein are consistent with the defined mission of the USPTO to help applicants get valid and enforceable patents on their Inventions. See, e.g., 1998 USPTO Annual Report by then Commissioner Bruce A. Lehman available on the USPTO website at <http://www.uspto.gov/web/offices/com/annual/1998/a98r-2.htm#Topic11>, "The mission of the patent business area is to help our customers get patents; its performance goal is to grant patents to inventors for their discoveries."

And if in considering a document in an IDS filed after a Notice of Allowance, an Examiner determined that the document would establish a *prima facie* case of unpatentability of an allowed claim, the Examiner has authority to withdraw the Notice of Allowance, reopen the prosecution of the application and reject the claim on the recently cited documents.

Indeed, 37 C.F.R. § 1.313(a) provides that "[a]pplications may be withdrawn from issue for further action at the initiative of the" USPTO. 37 C.F.R. § 1.313(b) further provides that the USPTO can withdraw an application from issue after payment of the issue fee due to, *inter alia*, unpatentability. Section 1308 of the MPEP provides that:

An application may be removed from the Office of Patent Publication, without it being withdrawn from issue under 37 CFR 1.313(b), to permit the examiner to consider an

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information disclosure statement or whether one or more claims are unpatentable. Only if such consideration results in a determination that one or more claims are unpatentable does 37 CFR 1.313(b) authorize the application to be withdrawn from issue. [emphasis added]

Thus, 37 C.F.R. § 1.97(i) does not prohibit the Examiner from considering an IDS that may not comply with 37 C.F.R. §§ 1.97 and 1.98, such as an IDS after allowance that may not comply with 37 C.F.R. §§ 1.97 and 1.98. Rather, 37 C.F.R. 1.97(i) is a procedural safeguard that prevents Applicants from expecting or insisting upon consideration of an IDS that may not comply with 37 C.F.R. §§ 1.97 and 1.98. And, in fact, as the application is now electronic, consideration of such an Information Disclosure Statement does not require the physical removal or transfer of the application itself, thereby simplifying the process and reducing any hardship on the Examiner.

Therefore, it is respectfully requested under all of the Rules, including 37 C.F.R. §§ 1.181-1.183 that the documents cited herein be considered and made of record. The Examiner is invited to contact the undersigned by telephone at (212) 588-0800 should there be any questions.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP  
Attorneys for Applicants

By:

  
Thomas J. Kowalski, Reg. No. 32,147  
Angela M. Collison, Reg. No. 51,107  
(212) 588-0800